REMARKS

The specification has been amended to update the recitation of U.S. government rights to the invention claimed herein.

In the response to the requirement for restriction under 35 U.S.C. 121, applicants hereby provisionally elect for further prosecution at this time, with traverse, the claims of Group I, namely claims 1-4 and 16-20, inclusive, drawn to certain methods of ameliorating tissue damage from vascular leakage or edema by treatment with compositions of PP1 and pharmaceutical products therefor.

Reconsideration of the present 15-way requirement for restriction is requested.

Applicants respectfully submit that at least claims of Groups I and II, i.e., claims 1-4 and 16-20, should be examined together. The claims of Groups I and II are both classified in Class 424, subclass 94.6, thus no undue searching burden would be imposed on the Examiner.

Applicants further request that this Restriction Requirement be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §1.141. 35 U.S.C. §121 provides that the Commissioner may restrict an application when "two or more independent and distinct inventions are claimed in a single application." (emphasis added). Similarly, 37 C.F.R. §1.141 (a) permits restriction conditioned upon the finding that independent and distinct inventions are found within a single application. There is no indication that Groups I and II are independent inventions

In fact, applicants submit that these two groups are not independent. For two or more inventions to be considered independent, there must be no disclosed relationships between the inventions in question, i.e., they are unconnected in design, operation or effect. M.P.E.P. §802.01. The subject matter in Groups I and II is directed to two structurally related compounds both of which have been shown to block Src family kinase activity.

Therefore, it is clearly evident that these groups of claims have a disclosed relationship and are, therefore, not independent. In light of the foregoing statutory and regulatory criteria, the present Restriction Requirement cannot be maintained since the inventions are not independent from one another.

Moreover, applicants submit that the alleged inventions have not acquired a separate status in the art, as alleged in the Restriction Requirement.

The classes to be searched have been identified. The class and subclass for the claims in Groups I and II are identical. A single search will provide pertinent art for the claims in Groups I and II. No divergent fields of search will be involved.

The M.P.E.P. §808.02 provides guidance here:

> Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate classification and field of search, no reasons exist for dividing among related inventions. (emphasis added).

Since the Examiner's search will cover the claims in Groups I and II, at least the Requirement for Restriction among these two groups should be reconsidered and withdrawn.

Furthermore, the Restriction Requirement is not in compliance with the M.P.E.P. It is well established that the Office Action must provide a rationale on the record to support a Restriction Requirement. More specifically, M.P.E.P. §808 states:

> The requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the invention as claimed are either independent or distinct and (2) the reasons for insisting upon restriction therebetween.... (emphasis in original).

In the present case, the Office Action has failed to show or provide adequate reasoning to support the Restriction Requirement. The Office Action concludes that each group represents a separate and distinct invention, without providing adequate evidence in support thereof. More specifically, the Office Action cites no reference or teaching that supports the allegation in the Office Action that the claims in the various groupings are patentably distinct. The Office Action merely concludes that the various groups are regarded as distinct and independent. Consequently, the Restriction Requirement is not in compliance with M.P.E.P. §808, and withdrawal thereof is respectfully requested.

It is also noted that the Requirement for Restriction is not mandatory under 35 U.S.C. §121 and 37 C.F.R. §1.142 but is merely discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made Restriction Requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. See, for example, Eversharp, Inc. v. Phillip Morris, Inc., 256 F. Supp. 778, 150 U.S.P.Q. 98 (E.D.Va. 1966); aff'd 374 F.2d 511, 153 U.S.P.Q. 91 (4th Cir. 1967). Therefore, to promote the interest of both the public and the

applicant, the Restriction Requirement should not be imposed without a specific analysis which supports the conclusions that two or more independent and distinct inventions are indeed claimed in one application.

The courts have recognized the advantages of the public interest to permit patentees to claim all aspects of their invention, as the applicants have done herein, so as to encourage the patentees to make a more detailed disclosure of all aspects of their invention. The CCPA observed long ago:

> We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112, all aspects of what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 177 U.S.P.Q. 250, 256 (C.C.P.A. 1973).

Furthermore, applicants respectfully request that in view of increased Official Fees and the potential limitations of applicant's financial resources, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive, and thereby contravenes the constitutional intent to promote and encourage the process of science and the useful arts.

Hence, it is respectfully requested that the Examiner reconsider and withdraw the Restriction Requirement, and provide an action on the merits with respect to all of the claims.

Attached hereto is a document captioned "Version With Markings To Show Changes Made" which is a marked-up version of the amendments made to the specification.

Respectfully submitted,

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CERTIFICATION UNDER 37 CFR 1.10

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I hereby certify that this AMENDMENT AND RESPONSE, together with any other documents and/or fees referred to as enclosed herein, is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service on December 17, 2001 and is addressed to: Commissioner for Patents, Washington, D.C. 20231.

Cederic Rodgers
(Typed or printed name of person mailing paper or fee)

(Signature of person mailing paper or fee)

Version With Markings To Show Changes Made

Amendments to the Specification:

The paragraph beginning at page 1, line 6, has been amended as follows:

This application is a continuation-in-part of ~~claims priority to~~ U.S. Patent Application Serial No. 09/470,881, filed Dec. 22, 1999, which claims priority to International Patent Application Number PCT/US99/11780, designating the United States of America and filed May 28, 1999, which claims priority to United States Provisional Application for Patent Serial No. 60/087,220 filed May 29, 1998.

The paragraph beginning at page 1, line 15, has been amended as follows:

This invention was made with government support under Contract Nos. CA 50286, CA 45726, CA 78045, CA 75924, HL 54444 and HL 09435 by the National Institute of Health. The government has ~~Some of the work disclosed has been supported in part by grants from the NIH on behalf of The United States of America. Therefore, the government of the United States of America may have~~ certain rights in the invention.